

REMARKS

1. In response to the Office Action mailed July 18, 2006, Applicant respectfully requests reconsideration. Claims 36-40 and 45-48 were last presented in this application. In the outstanding Office Action, claims 36, 45 and 46 were rejected and claims 37-40, 47 and 48 were objected to. By the foregoing Amendments, no claims have been amended, canceled or added. Thus, upon entry of this paper, claims 36-40 and 45-48 will remain pending in this application. Of these nine (9) claims, two (2) claims (claims 36 and 45) are independent.

Appeal

2. Applicant appealed from the decision of the primary examiner to the Board of Patent Appeals and Interferences by filing a Notice of Appeal on February 22, 2006. An Appeal Brief was subsequently filed April 24, 2006. No Examiner's Answer was issued in the appeal. Rather, in response to Applicant's appeal brief this application was returned to prosecution resulting in the mailing of this non-final Office Action on July 18, 2006.

Allowable Subject Matter

3. Applicant notes with appreciation the Examiner's indication that claims 37-40 and 47-48 would be allowable if rewritten in independent form including all of the limitations of their respective base claim and any intervening claims.

Claim Rejections

4. Independent claims 36 and 45 and dependent claim 46 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,896,875 to W.E. Reed, *et al.* (hereinafter, "Reed"). Based on the following Remarks, Applicant respectfully requests that these rejections be reconsidered, and that they be withdrawn.

5. The Reed device is a motor driven fishing reel that relies on one or more batteries within the device to power the motor. (*See*, Reed, col. 1, lns. 15-19.) The batteries 22 are maintained in place by, among other things, a coiled spring 18. The coiled spring has a planar contact 20 at its narrow end, and is secured to the battery casing 10 at its wide end. (*See*, Reed, col. 2, lns. 8-13; Fig. 1.)

6. In the Office Action the Examiner asserts that Reed substantially teaches Applicant's invention as recited in independent claims 36 and 46. The Examiner acknowledges, however, that "Reed does not expressly disclose a coil that scrapes away a portion of the insulating contaminant layer from a surface of an abutting terminal (claims 36 and 45), or as means for rupturing an insulating contaminant layer on a localized region of an abutting battery terminal surface (claim 45)." (*See*, Office Action, pg. 5.)

7. The Examiner asserts, however, that it would have been obvious to one of ordinary skill in the art at the time the invention was made "to employ a spring contact [as claimed]" because "it has been held that rearranging parts of an invention involves only routine skill in the art." The underlying rationale for this rejection is that "[t]he skilled artisan recognizes that deformities in the spring from normal wear and tear will rearrange parts of the coil, forming means [for] scraping away a portion of an insulating contaminant layer from a surface of an abutting terminal of an installed battery. With regard to claim 45, the Examiner asserts that "the coiled spring contact, through normal wear and tear, would form means for rupturing an insulating contaminant layer on a localized region of an abutting battery terminal surface. (*See*, Office Action, page 5.) Applicant respectfully traverses these rejections.

8. Nowhere in the art of record is there any disclosure, teaching or suggestion that wear and tear of conventional coiled spring battery contacts such as Reed's coiled spring 18 would cause the coiled spring to develop "deformities" which will "rearrange parts of the coil" resulting in the formation of "means for scraping away" and "means for rupturing" an insulating contaminant layer from a surface of an abutting terminal of an installed battery." Rather than identifying support for the Examiner's proposition, the Examiner simply asserts that "a skilled artisan recognizes" such aspects of a coiled spring battery contact. However, it is never appropriate for an Examiner to rely solely on common knowledge in the art as the principal evidence upon which a rejection is based without evidentiary support in the record. (*See*, MPEP §2144.04, citing *Zurko*, 285 F.3d 1386.) As such, Applicant respectfully requests that the Examiner either provide documentary evidence supporting the Examiner's contention, or withdraw these rejections.

9. Moreover, if the Examiner is relying on the theory of inherency or facts within his personal knowledge, the Examiner has failed to satisfy the requirements of MPEP §2112 (requiring the Examiner to provide a basis in fact and/or technical reasoning to reasonably support a determination that the allegedly inherent characteristic necessarily flows from the

teachings of the applied reference; and further noting that the fact that a certain characteristic may be present is not sufficient) and 37 C.F.R. §1.104(d)(2) (requiring the examiner to provide an affidavit or declaration setting forth specific factual statements and explanation if the Examiner is relying on facts within his personal knowledge).

10. For at least the above reasons, Applicant respectfully asserts that there is no express, implicit or inherent disclosure in Reed or the other art of record indicating that the Reed device performs the alleged function recited in Applicant's claims 36 and 45. Applicant therefore respectfully asserts that the rejections of independent claims 36 and 45 are improper and should be withdrawn.


Dependent Claims

11. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them *a fortiori* independently patentable over the art of record. Accordingly, Applicant respectfully requests that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

12. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,



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